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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/337,243 06/22/99 MAURER

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PM82/0522

EXAMINER

SAFAV T, M

ART UNIT PAPER NUMBER

3635

4

DATE MAILED:

05/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.	337243	Applicant(s)	MAURER
Examiner	SAFAV	Group Art Unit	3635

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

Responsive to communication(s) filed on JUNE 22, 1999.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

Claim(s) 1-25 is/are pending in the application.

Of the above claim(s) 16-25 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-5, 8-15 is/are rejected.

Claim(s) 6, 7 is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 & 3

Notice of References Cited, PTO-892

Notice of Draftsperson's Patent Drawing Review, PTO-948

Interview Summary, PTO-413

Notice of Informal Patent Application, PTO-152

Other \_\_\_\_\_

## Office Action Summary

Art Unit:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15 are, drawn to molding, classified in class 52, subclass 287.1.
  - II. Claims 16-19 and 23 are, drawn to method of installing a molding, classified in class 156, subclass 249.
  - III. Claims 20-22 are, drawn to apparatus for applying a molding, classified in class 33, subclass 420.
  - IV. Claim 24 is, drawn to molding adapter, classified in class 428, subclass 40.1.
  - V. Claim 25 is, drawn to method of installing a molding, classified in class 156, subclass 227.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case claim molding can be applied in one motion as without flexing.
4. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as use as a trim by itself. See MPEP § 806.05(d).

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5. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as use as trim strip by itself. See MPEP § 806.05(d).

6. Inventions I and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case claim molding can be applied without use of any particular adapter.

7. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case claimed process does not need the claimed apparatus to install the molding.

8. Inventions IV and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case claimed molding adapter can be used by itself as a trim.

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9. Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions appear as mutually exclusive with respect to installing a molding.

10. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are used separately.

11. Inventions III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are used separately.

12. Inventions IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case claimed molding adapter can be used as a trim by itself as by not folding.

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13. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

14. During a telephone conversation with Mr. John Murtaugh on January 31, 2001 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-

15. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 16-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

16. Claims 1-5 and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson.

Johnson shows a flexible polyvinyl plastic foam member 12/18 having pressure sensitive adhesive 19 affixed to a rear side thereof with a release strip 20 covering the adhesive layer.

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17. Claim 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Spector. Spector shows a flexible plastic foam member 15/16/17 having pressure sensitive adhesive 18 affixed to a rear side thereof with a release strip 19 covering the adhesive layer. Member 15/16/17 is packaged in a roll form.

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson.

To have formed the Johnson molding of a length greater than 30 feet, thus accommodating any particular stretch of corner to be decorated, would have constituted an obvious expedient to one of ordinary skill in the art.

20. Claims 1-5 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finefrock. Finefrock shows a flexible rubber or other elastomeric member 11 having pressure sensitive adhesive 16, 17 affixed to a rear side thereof with a release strip 19, 20 covering the adhesive layer. To have formed the Finefrock member 11 of a plastic foam rubber material such as a rubber latex or a polyethylene foam, thus affording the desired properties of Finefrock with a

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cost effective material, would have constituted an obvious expedient to one of ordinary skill in the art. Forming the Finefrock molding of a length greater than 30 feet, thus accommodating any particular stretch of corner to be decorated, would have constituted a further obvious expedient to one of ordinary skill in the art.

21. Claims 1-5 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan in view of either of Johnson or Finefrock. Logan shows, Figs. 2, 4, and 6, a flexible plastic foam member 10 having pressure sensitive adhesive 20 affixed to a rear side thereof. Each of Johnson and Finefrock teach utilization of a release strip to cover an adhesive layer affixed to a rear surface of a molding strip. To have provided the Logan molding with a release strip covering the adhesive layer 20 along a rear surface of the molding, thus providing protection for the adhesive strip prior to application along a wall, would have constituted an obvious expedient to one of ordinary skill in the art as taught by either of Johnson at 20 or Finefrock at 19, 20. To have formed the Logan member 10 of a plastic foam material such as a polyethylene foam, thus affording the desired properties of Logan with a cost effective material, would have constituted an obvious expedient to one of ordinary skill in the art. Forming the Logan molding of a length greater than 30 feet, thus accommodating any particular stretch of corner to be decorated, would have constituted a further obvious expedient to one of ordinary skill in the art.

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22. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



MICHAEL SAFAVI  
PRIMARY EXAMINER  
ART UNIT 354

M. Safavi  
May 18, 2001